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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICIAL

Applicant(s): Goldberg	
Application No.: 10/009,874	Group Art Unit: 1636
Filed: 12/11/2001	Examiner: S. Kaushal
Title: Gene and Protein Sequences of Phage T4 Gene 35	Confirmation No.: 4607
Attorney Docket No.: NANF.P-007	

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

PETITION FOR REVIEW OF RESTRICTION REQUIREMENT

Dear Sir:

Applicants requests review of the Restriction Requirement imposed on August 8, 2003, and made Final in the Official Action mail December 18, 2003 for the above-captioned application. In a response to the restriction requirement, Applicants elected the claims of Group I, namely claims 1-4, 7-24, and 46-47 with traverse. The reason for the restriction is the Examiner's assertion that the proteins of Group I and the corresponding nucleic acids sequences of Group II lack unity of invention under PCT Rule 13.1. This assertion is directly contradictory to the PCT Administrative Instructions, and in particular to Example 17. Copies of the relevant pages from the MPEP Appendix are attached.

I hereby certify that this paper and any attachments named herein are transmitted to the United States Patent and Trademark Office, Fax number: (703) 872-9306 on January 12, 2004.

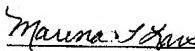
Marina T. Larson  
Marina T. Larson, PTO Reg. No. 32,038

January 12, 2004  
Date of Signature

In view of the fact that the Examiner's reasons for restriction are inconsistent with established and published rules relating to Unity of Invention, Applicant submits that the restriction requirement should have been withdrawn and all claims considered in this application. The Examiner refused to do this, and did not even comment on the provided section of the PCT Administrative Instructions. Instead, he applied a standard under which he asserted that the proteins and nucleic acids were distinct inventions because they could be used for different purposes. This is improper in a PCT National Phase case. Thus, the Examiner should be instructed to withdraw the restriction requirement and consider all of the claims in this application.

No fees are believed to be due with this petition. However, the Commissioner is authorized to charge any fees deemed to be due to Deposit Account No. 15-0610.

Respectfully submitted,

  
Marina T. Larson Ph.D.  
PTO Reg. No. 32,038  
Attorney for Applicant  
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## MANUAL OF PATENT EXAMINING PROCEDURE

Claim 3: A display with features A + B with additional feature D.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is features A + B.

**Example 13**

Claim 1: Filament A for a lamp.

Claim 2: Lamp B having filament A.

Claim 3: Searchlight provided with lamp B having filament A and a swivel arrangement C.

Unity exists between claims 1, 2, and 3. The special technical feature common to all the claims is the filament A.

**Example 14**

Claim 1: A marking device for marking animals, comprising a disc-shaped element with a stem extending normally therefrom, the tip of which is designed to be driven through the skin of the animal to be marked, and a securing disk element to be fastened to the protruding tip of the stem on the other side of skin.

Claim 2: An apparatus for applying the marking device of claim 1, constructed as a pneumatically actuated gun for driving the stem of the disc-shaped element through the skin, and provided with a supporting surface adapted for taking up a securing disc element, to be placed at the other side of the body portion in question of the animal to be marked.

The special technical feature in claim 1 is the marking device having a disc-shaped element with a stem and a securing disc element to be fastened to the tip of the stem. The corresponding special technical feature in claim 2 is the pneumatically actuated gun for driving the marking device and having a supporting surface for the securing disc element. Unity exists between claims 1 and 2.

**Example 15**

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

**Example 16**

Claim 1: An insecticide composition comprising compound A (consisting of  $a_1, a_2, \dots$ ) and a carrier.

Claim 2: Compound  $a_1$ .

All compounds A are not claimed in the product claim 2 for reasons of lack of novelty of some of them for instance. There is nevertheless still unity between the subject matter of claims 1 and 2 provided a 1 has the insecticidal activity which is also the special technical feature for compound A in claim 1.

**Example 17**

Claim 1: Protein X

Claim 2: DNA sequence encoding protein X.

## ADMINISTRATIVE INSTRUCTIONS UNDER THE PCT

Expression of the DNA sequence in a host results in the production of a protein which is determined by the DNA sequence. The protein and the DNA sequence exhibit corresponding special technical features. Unity between claims 1 and 2 is accepted.

## III. MARKUSH PRACTICE

**Example 18**— common structure:

Claim 1: A compound of the formula:

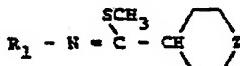


wherein R<sup>1</sup> is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; R<sup>2</sup>-R<sup>4</sup> are methyl, benzyl, or phenyl. The compounds are useful as pharmaceuticals for the purpose of enhancing the capacity of the blood to absorb oxygen.

In this case the indolyl moiety is the significant structural element which is shared by all of the alternatives. Since all the claimed compounds are alleged to possess the same utility, unity is present.

**Example 19**— common structure:

Claim 1: A compound of the formula:



wherein R<sub>1</sub> is selected from the group consisting of phenyl, pyridyl, thiazolyl, triazinyl, alkylthio, alkoxy, and methyl; Z is selected from the group consisting of oxygen (O), sulfur (S), imino (NH), and methylene (-CH<sub>2</sub>-). The compounds are alleged to be useful as pharmaceuticals for relieving lower back pain.

In this particular case the iminothioether group -N=C-SCH<sub>3</sub> linked to a six atom ring is the significant structural element which is shared by all the alternatives. Thus, since all the claimed compounds are alleged to possess the same use, unity would be present. A six membered heterocyclic ring would not have been of sufficient similarity to allow a Markush grouping exhibiting unity, absent some teaching of equivalence in the prior art.

**Example 20**— common structure

Claim 1: A compound of the formula:

